

REMARKS/ARGUMENTS

In view of the amendments and remarks herein, favorable reconsideration and allowance of this application are respectfully requested. By this Amendment, claims 43 and 53 have been amended solely for clarity. Thus, claims 43-79 are pending for further examination.

Rejection under 35 U.S.C. § 102(b)

Claims 43-45, 47-49, 53-55, 57-63, and 65-67 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Knowles (U.S. Patent No. 5,481,509). This rejection once again is respectfully traversed for at least the following reasons.

Applicant previously argued that Knowles fails to disclose “a first storage location storing a first plurality of instances of media available for playback via the jukebox device for a first fee or number of credits; [and] a second storage location storing a second plurality of instances of media available for playback via the jukebox device for a second fee or number of credits, the second fee or number of credits being higher than the first fee or number of credits,” as recited in claim 43, and the corresponding features of claims 53 and 61. The Examiner is thanked for providing the detailed “Response to Arguments” section of the Office Action. However, as explained in greater detail below, the arguments provided in this section still do not establish a prima facie case of anticipation with respect to claims 43, 53, and 61.

Applicant does not necessarily disagree with the assertion that a CD 104, a VCR 106, and a laser disk 108 are storage locations. Nor does Applicant necessarily disagree with the assertion that these alleged “storage devices store one or more pieces of media ‘available for playback.’” However, Applicant strongly disagrees with the Office Action’s implicit assertion that the above-quoted and corresponding features of claims 43, 53, and 61 simply can be ignored for the

purposes of examination, even if claims 43 and 53 are “understood to be apparatus claims.” Indeed, it is beyond dispute that each and every limitation of a claim must be considered during prosecution before the USPTO, and the invention “as a whole” must be considered. Applicant respectfully submits that these basic examination requirements have not been met here.

Moreover, there is nothing inherently “wrong” with reciting the functional aspects of a structure. *See, e.g., R.A.C.C. Indus. v. Stun-Tech, Inc.*, 178 F.3d 1309 (Fed. Cir. 1998) (unpublished); MPEP 2106. Indeed, in computer-related inventions, the structure of programmed logic circuitry often is best understood in terms of its function. Such certainly is the case here, where claims 43 and 53, for example, make it abundantly clear what types of media each storage location stores (thereby clearly emphasizing structure) and how and when each instance of media stored on a particular storage location can be played back (thereby explaining structure through function, e.g., in explaining how the logic circuitry is programmed within providing volumes of code).

Furthermore, the Office Action’s citation to MPEP 2106 for the proposition that “intended use” limitations can somehow be “given less weight” is not understood. As far as Applicant can discern, MPEP 2106 contains guidelines for assessing patent subject matter eligibility as opposed to claim interpretation or how to treat “intended use” or “functional language.”

Notwithstanding the above, Applicant notes that claim 61 is a method claim. Thus, to the extent that there is any objectionable functional or intended use language in claims 43 or 53, such is entirely proper within the context of a method claim. Thus, in addition to the reasons provided above, the Section 102 rejection of claim 61 is facially improper.

Aside from the clear errors in claim interpretation and examination, Applicant further notes that the Office Action includes factual inaccuracies regarding the scope and content of Knowles. Although the Office Action properly notes that Knowles at col. 6, lines 50-52 discloses a price being associated with a title available for playback, the Office Action errs in alleging that “Knowles reasonably teaches one of ordinary skill that different prices can be charged for different formats and different formats can be stored in different locations.” Knowles is completely silent regarding any form of price differentiation. In fact, the portions cited in the Office Action for this proposition repeatedly have been wholly unrelated to the idea of charging different prices for instances of media stored on different storage locations. As the MPEP makes clear, a claim cannot be anticipated unless the “identical invention” is disclosed in a single reference. That single reference must also disclose the “identical invention” in as much detail as that which is claimed. Knowles clearly fails to disclose charging different prices for different instances of media stored on different storage locations. Because of these factual errors, it is yet more clear that the Section 102 rejection is improper.

To avoid any further doubt (but without acquiescing to the propriety of the rejection), Applicant has amended claims 43 and 53 to make clear that the user interface is configured to enable a user to select an instance of media available for playback from the first and second pluralities of instances of media in order to initiate playback of the selected instance of media on the jukebox device following collection of an appropriate fee or number of credits. This language presents yet a further structural limitation, as it relates to the structural configuration of the claimed user interface. In particular, it is now yet clearer that the user interface and the storage locations work together to enable a user to select an instance of media and to have the selected instance of media played back following collection of an appropriate fee or number of

credits. As explained in detail above and in Applicant's previous Amendments/Responses, Knowles is silent regarding this subject matter.

In view of the above, reconsideration and withdrawal of the outstanding Section 102 rejection are respectfully requested.

Rejections under 35 U.S.C. § 103(a)

Claims 71-79 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Knowles in view of Shneidman (U.S. Publication No. 2006/0038794). This rejection once again is respectfully traversed for at least the following reasons.

Various features of claim 71 have not been accorded patentable weight because they have been interpreted as intended use or functional limitations. However, as explained in detail above, there is nothing inherently wrong with functional recitations in an apparatus claim. Indeed, the structure of a computer-implemented invention is perhaps best explained in terms of its function. Thus, the Office Action's indication that the phrase "'configured to enable' fails to make the limitation a positive recitation," to the extent understood or relevant, is inapposite, in that a computer-implemented element being "configured to" do something (1) is not inherently objectionable, (2) is a positive recitation (particularly in the context of claim 71), and (3) clearly and unambiguously denotes structure (again, particularly in the context of claim 71). In fact, it has been the undersigned's experience that most USPTO examiners now actually prefer the "configured to" language in connection with claims directed to computer-related inventions, e.g., as opposed to "capable of" or "can be" language. Nonetheless, if the Examiner here has some alternate preferred language that for some reason would be more acceptable, he is invited to contact the undersigned to propose the same.

Of course, Knowles does not explicitly disclose or inherently require charging a different price for the playback of media based on the display screen from which an instance of media is selected. Being able to select instances of media -- regardless of whether those instances of media come from the same or a different storage location -- does not equate to charging a different price for the playback of an instance of media based on the display screen from which the particular instance of media is selected. This technical deficiency with respect to Knowles is not cured by the introduction of Shneidman. Thus, notwithstanding the errors in claim interpretation and examination noted above, the Office Action also errs in resolving the scope and content of Knowles.

For at least the reasons provided above, Applicant respectfully submits that the alleged Knowles/ Shneidman combination fails to render obvious claim 71.

The rejections of claims 46, 50-52, 56, 64, 68-70 as allegedly being made "obvious" by various combinations of Knowles with Shneidman, Waingrow (the "Unix Hints & Hacks" publication), Bowman-Amuah (U.S. Patent No. 6,289,382), and Dunning et al. (U.S. Patent No. 7,024,485), are respectfully traversed. The fundamental deficiencies of Knowles have been described above, and the introduction of the other references fails to make up for these fundamental deficiencies. Thus, even if the prior art was combinable in the manner alleged in the Office Action (which Applicant does not concede), the various combinations of references still fail to render obvious claims 46, 50-52, 56, 64, 68-70.

Accordingly, reconsideration and withdrawal of all outstanding Section 103 rejections are respectfully requested.

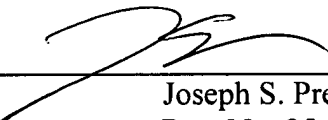
Conclusion

Applicant believes that all of the pending claims clearly and patentably distinguish the prior art of record and are in condition for allowance. Thus, passage of this case to issuance at an early date is earnestly solicited. Should the Examiner have any questions, or deem that any further issues need to be addressed prior to allowance, the Examiner is invited to call the undersigned attorney at the phone number below.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____


Joseph S. Presta
Reg. No. 35,329

JSP:jr
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100